

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

• • REMARKS/ ARGUMENTS • •

The Official Action of February 28, 2006 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

By the present amendment the limitations of claims 11 and 12 have been incorporated into independent claim 1.

This change to the claims is deemed proper after final inasmuch as it only involves combining the limitations of dependent claims with the claim from which they previously depended. That is, the changes to the claims do not present any new limitations in the prosecution.

Accordingly, entry of the amendments to the claims is respectfully requested.

Claims 1-4 remain pending in the present application.

Claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,369,545 to Wanberg.

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wanberg in view of U.S. Patent No. 4,808,175 to Hansen.

Claims 11 and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wanberg in view of U.S. Design Patent No. Des. 343,233 to Lanmon et al.

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

For the reasons set forth below, it is submitted that each of the pending claims are allowable over the prior art relied upon by the Examiner and therefore, each of the outstanding rejections of the claims should properly be withdrawn.

Favorable reconsideration by the Examiner is earnestly solicited.

Initially it is noted that inasmuch as the limitations of claims 11 and 12 have been incorporated into independent claim 1, the prior art rejections based upon Wanberg alone or Wanberg in view of Hansen are deemed moot and no comments concerning these rejections is believed to be necessary in the present response.

In the prior art combination of Wanberg and Lanmon et al. the Examiner has relied upon Wanberg as disclosing:

...the invention substantially as claim except for a colored pocket or cover having an indicator.

In relying upon Lanmon et al. the Examiner states:

With "colored" being defined as giving a distinctive character or quality to, and an indicator as being defined as a signal for attracting attention; Lanmon discloses a diaper with a distinguished coloring on the outer cover with a pocket without said coloring. The pocket has containment indicators such as "Wipe and Powder Puff" located thereon.

In combining the teachings of Wanberg and Lanmon et al. the Examiner takes the position that:

It would have been obvious....to modify Wanberg's pocket and backsheet with a design or colored feature and an indicator on the pocket as taught by Lanmon, to

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

distinguish the backsheet from the pocket, as well as, provide indication of the contents of the pouch.

The Examiner's reliance upon the prior art is not believed to support a prima facie case of obviousness for a number of reasons which will be addressed below.

First, it appears as though the Examiner has overlooked the fact the applicants previously amended their claims to recite that the opening of the insertion space was "non-sealable."

Moreover, the Examiner will note that the pouch of Wanberg is not only provided for purposes of disposing of the diaper and not for containing any items or objects.

These are significant points not to be overlooked.

If the pouch of Wanberg is not sealable (as required by applicants' claims), there is no reason for the Examiner to conclude that it would be obvious to modify Wanberg's pocket and backsheet with a design or colored feature and an indicator on the pocket as taught by Lanmon, to.... "provide indication of the contents of the pouch."

That is, if the pouch does not contain anything, there is no basis for modifying the pouch in any way to "provide indication of the contents of the pouch."

Accordingly, the basis for the Examiner's proposed modification is unfounded and cannot support a finding of obviousness when fully considering the limitations of applicants' claims).

Moreover, as indicated above, Wanberg does not teach that the pouch contains any items or objects.

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

Accordingly, it would not have been obvious to modify Wanberg's pocket and backsheet with a design or colored feature and an indicator on the pocket as taught by Lanmon, to...."provide indication of the contents of the pouch."

The Examiner has relied upon Lanmon et al. as disclosing:

...a diaper with a distinguished coloring on the outer cover with a pocket without said coloring. The pocket has containment indicators such as "Wipe and Powder Puff" located thereon

Since Lanmon et al. is a Design patent it is important to realize the limitations that are imposed on prior art references that are merely drawings.

MPEP 2121.04 states:

Pictures and drawings may be sufficiently enabling to put the public in the possession of the article pictured. Therefore, such an enabling picture may be used to reject claims to the article. However, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928)

This section of the MPEP cites *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). The Examiner will note that this case involves the applicability of a figure in a catalogue as a prior art reference. Among the issues that the court determined was whether the catalogue was a sufficient disclosure for the claimed subject matter.

In determining if the catalogue was a sufficient disclosure for the claimed subject matter the court relied upon the combination of the figure ("cut No. 712") and the written description of the figure, stating "That is was an adjustable candle socket the text itself declares." (*id.* at 814).

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

Thus in *Jockmus v. Leviton*, which is cited in MPEP 2121.04, the court determined that a drawing is a sufficient disclosure when considered together with, or interpreted in light of, the corresponding written text. That is, the court specifically relied upon the textural disclosure which supplemented what was shown in the figure, in order to find that the reference provided a sufficient disclosure.

In the present situation the only relevant textual information in Lanmon et al. is the title: "Diaper" and the description: "The ornamental design for a diaper, as shown and described."

Accordingly, it is important to realize that Lanmon et al. is a very limited reference. For example, it is not possible to tell whether the decorative pattern is a printed pattern or a pattern of cut-out portions of the diaper structure.

Further, Lanmon et al. makes no reference to different colors on portions of the diaper.

If anything, it appears that the shading on the "pocket" of Lanmon et al. indicates that the outer- or cover sheet is transparent and neither a different color from the other portions of the diaper nor an indicator element.

It is noted that since Lanmon et al. is a design patent it does not include any disclosure of utility (not protected by design patents) of any of the illustrated features.

Therefore, Lanmon et al. does not teach that the printed design pattern has any particular functionality or utility.

Accordingly, with regard to the printed pattern illustrated in Lanmon et al. it is noted that:

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

1) The design pattern is not even identified as being a different color from the topsheet and backsheet (an could very well merely be a cut out, embossed or some other type of formed pattern);

2) The design pattern is in fact on the backsheet and therefore does not provide a separate element that has a different color from the backsheet; and

3) The sheet upon which the design pattern is provided is not a cover sheet that is separate from the backsheet as required by applicants' claims.

Whereas the Examiner may proffer that:

It would have been obvious....to modify Wanberg's pocket and backsheet with a design or colored feature and an indicator on the pocket as taught by Lanmon, to distinguish the backsheet from the pocket, as well as, provide indication of the contents of the pouch,

Lanmon et al. does not teach or suggest that the overlying sheet 5 of Wanberg (as opposed to the back sheet 4) should be a "design or colored feature" which is different from that of the topsheet and backsheet.

When applying references to determine obviousness it is important to determine whether an applicant's invention involves the discovery or solution of a specific problem in the art.

In the present situation is noted that the diaper of Lanmon et al. includes a number of features such as the fastening tapes, the landing areas for the fastening tapes, and pockets (absent the indicia "WIPE" and "POWDER PUFF") which would readily enable a user to distinguish the backsheet of the diaper from the topsheet.

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

Accordingly, it has not been shown that Lanmon et al. addresses the particular problem which applicants' invention addresses and solves.

That is, as discussed in the third full paragraph on page 13 of applicants' specification:

Such a unique arrangement facilitates the wearer 20 to identify the surface to be placed against the wearer's body (topsheet 2) and to recognize the presence of the pocket P1.

As can be understood, applicants' use of a different color for the cover sheet and the use of the indicator element aids in identifying and distinguishing the side of the diaper that is to be placed against the wearer.

Neither Wanberg nor Lanmon et al. even recognize such a problem exists, much less address or provide a solution to the problem.

Accordingly, the combination of Wanberg and Lanmon et al. does not render applicants' invention obvious.

It is further noted that the teachings of Wanberg and Lanmon et al. are not even closely related enough to be combinable.

Wanberg teaches a "pouch" which is configured to be used to dispose of the diaper and is not taught as containing any items or objects.

Lanmon et al. appears to teach a pocket structure that is used to contain "WIPES" and "POWDER PUFFS."

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

Modifying the diaper of Wanberg to have the pocket or features of the pocket of Lanmon et al. (i.e. what the Examiner refers to as the "containment indicators") does not benefit the structure or function of the "pouch" of Wanberg.

Accordingly, any modification of Wanberg in view of Lanmon et al., as regards the pocket of Lanmon et al., is not supported by obviousness as required under 35 U.S.C. §103.

It is noted that Wanberg does not teach any reason to include a different color or indicator element according to the present invention. In this regard it can be assumed that Wanberg does not encounter any problems in distinguishing which side of the diaper to place against the skin of a wearer. In this regard, it can be concluded that at the time of Wanberg's invention the topsheets were quite easily distinguishable from the backsheets which, as indicated by Wanberg were thermoplastic films (whereas the topsheet were softer fluid pervious sheet materials).

With the advance of softer backsheet materials used in present day diapers, the use of different colors or indicator elements according to the present invention can be a great assistance in distinguishing which side of the diaper is to be placed against the skin of a wearer, especially when one is having difficulty putting the diaper on a baby.

Finally it is questioned where the Examiner has obtained the relied upon definition of "colored" and concluded that a "distinctive character" or "design" necessarily encompasses a different color.

Based upon the above distinctions between the prior art relied upon by the Examiner and the present invention, and the overall teachings of prior art, properly considered as a whole, it is

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

respectfully submitted that the Examiner cannot rely upon the prior art as required under 35 U.S.C. §102 as anticipating applicants' claimed invention.

Moreover the Examiner cannot rely upon the prior art as required under 35 U.S.C. §103 to establish a prima facie case of obviousness of applicants' claimed invention.

It is, therefore, submitted that any reliance upon prior art would be improper inasmuch as the prior art does not remotely anticipate, teach, suggest or render obvious the present invention.

It is submitted that the claims, as now amended, and the discussion contained herein clearly show that the claimed invention is novel and neither anticipated nor obvious over the teachings of the prior art and the outstanding rejection of the claims should hence be withdrawn.

Therefore, reconsideration and withdrawal of the outstanding rejection of the claims and an early allowance of the claims is believed to be in order.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

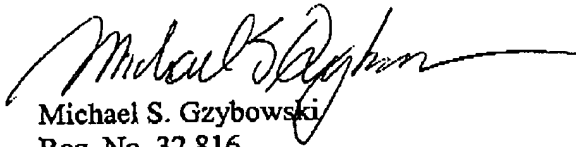
If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

Appl. No. 10/670,019
Amdt. Dated April 28, 2006
Reply to Office Action of February 28, 2006

time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

146288.1